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| 50170 7590 12/09/2008 IBM CORP. (WIP) c/o WALDER INTELLECTUAL PROPERTY LAW, P.C. 17330 PRESTON ROAD SUITE 100B DALLAS, TX 75252 | | | EXAMINER FISCHER, ANDREW J | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/884,296
Filing Date: June 19, 2001
Appellant(s): ADLER ET AL.

Paul D. Heydon
For Appellant

EXAMINER'S ANSWER

This is in response to the Remand from the BPAI filed 12 January 2006.

Art Unit: 3621

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is not correct. This Examiner's Answer contains a new grounds of rejection.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,689,565

Spies et al.

11-1997

EP 1,081,916 A2 US King 07-2000

Kroenke, David M. "Database Processing: Fundamentals, Design, and Implementation"

Art Unit: 3621

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for;all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 6, 7, 11, and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over King (EP 1,081,916 A2), in view of Kroenke, "Database Processing: Fundamentals, Design, and Implementation"(c) 1999.

Claims 1, 6, and 11:

King as shown, discloses the following limitations:

- identifying the parties involved in a process of handling personally identifiable information (page 4, lines 30-31);
- identifying the data involved in said process (page 4, lines 42-43);

Art Unit: 3621

- classifying the data (page 5, lines 50-51); • expressing each relationship between each pair of said parties in terms of a privacy agreement (page 4, lines 30-31);
- said privacy agreement is specific to a single purpose (page 8, lines 1-50).
- said privacy agreement expresses rules regarding said privacy-related actions, for each of said parties (abstract);

King does not specifically disclose the following limitations, but Kroenke, as shown does.

- representing said parties, said data, and said privacy agreements graphically in one or more privacy agreement relationship diagrams (Figures 3-3 to 3- 11), wherein:
- said privacy agreement uses a limited number of privacy-related actions concerning said personally identifiable information (Figure 3-15);

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine King's method and system for exchanging sensitive information with Kroenke's relational database management system because the RDBMS allows entities and classes each with their own attributes to be modeled in relation to each other so as to form a construct that relies relationships and rules that would permit the use, access, and modification of sensitive personal information quickly and easily, as well as securely.

Claims 2, 7, and 12:

King discloses exchanging sensitive information as shown above. King does not specifically disclose mapping a business process to the privacy rules that should govern the behavior of each pair of parties. However, Kroenke discloses entity relationship diagrams that

Art Unit: 3621

show cardinality between classes and entities (see at least Figures 3-3). Kroenke also discloses that there are many different ways of modeling a business situation using the relational database environment (page 67). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine King's method and system for exchanging sensitive information with Kroenke's relational database management system because the RDBMS allows entities and classes each with their own attributes to be modeled in relation to each other so as to form a construct that relies on relationships and rules that would permit the use, access, and modification of sensitive personal information quickly and easily, as well as securely.

Claims 3-5, 8-10, and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over King (EP 1,081,916 A2), in view of Kroenke, "Database Processing: Fundamentals, Design, and Implementation"(c)1999, and further in view of Spies et al. (US 5,689,565).

Claims 3-5, 8-10, and 13-15:

King discloses exchanging sensitive information as shown above. King does not specifically disclose mitigating the risks associated with handling sensitive information. Spies, however, in column 1, lines 26-29, states, "To provide a secure interchange of information in the electronic arena, one traditional approach to mitigating the risk of having sensitive information intercepted was to institute proprietary computerized systems that were closed to the general public." Although Spies does not specifically teach identifying opportunities to reduce privacy-related risks involved in said process, identifying unnecessary exchanges of data for possible elimination, and identifying opportunities to transform data into a less sensitive form, Spies

Art Unit: 3621

shows that mitigating risk associated with personal, sensitive information has been addressed by reducing and restricting the access that individuals and organizations have private data.

Identifying opportunities to reduce the risk by reducing unnecessary changes to the data and transforming data into a less sensitive form are obvious ways of mitigating the risk of inadvertently releasing sensitive information into the hands of persons who are not authorized access to such a data. Spies, as shown above, foresees this risk and accomplishes the same resolution under the umbrella of reducing the exposure of sensitive information to authorized personnel.

NEW GROUNDS OF REJECTION

Claim Rejections - 35 USC § 101

Claims 1-5 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent¹ and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008) (en banc).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively

¹ See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

Art Unit: 3621

recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.

In this particular case, the claim(s) fail prong (1) because the method steps are not tied to a machine and can be performed without the use of a particular machine. In this case, the method steps appear to be purely mental processes. Additionally, the claim(s) fail prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.

(10) Response to Argument

Issue 1

With regard to the rejection of claims 1-5 35 U.S.C. 101, appellant argues that this is an improper rejection. However, as stated in MPEP 2106 II.A, when a claim is devoid of technological application, it should be rejected. Appellant cites *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F. 3d 1368, 1373, 47 USPQ2d 1596, 1601-02 (Fed. Cir. 1998), cert. denied, 525 U.S. 1093 (1999). However, the Examiner is not asserting that the claimed invention does not produce a useful, concrete or tangible result. Appellant's argument is misplaced and therefore moot. Appellant also cites *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1358, 50 USPQ2d 1447, 1452 (Fed. Cir. 1999). In this case, the appellants claims do not come close to rising to the level In *Ex parte Bowman* 61 USPQ2D 1669, the Board of patent Appeals and Interferences states, "The phrase 'technological arts' has been created to offer another view of the term 'useful arts.' The Constitution of the United States authorizes and

Art Unit: 3621

empowers the government to issue patents only for inventions which promote the progress [of science and] the useful arts. We find that the invention before us, as disclosed and claimed, does not promote the progress of science and the useful arts, and does not fall within the definition of technological arts. The abstract idea which forms the heart of the invention before us does not become a technological art merely by the recitation in the claim of transforming physical media into a chart' [sic, drawing or creating a chart] and 'physically plotting a point on said chart'." Clearly, the BPAI requires a technological aspect to the claims, which the claim language currently lacks, as written.

Issue 2

The appellant asserts that King's "privacy agreement" clearly does not have the same meaning, and does not have the breadth of utility shown for a privacy agreement in the subject patent application. The Examiner respectfully disagrees and points to the appellant's specification, page 20, lines 28-29, wherein the appellant unmistakably states, "The (privacy) agreement can be between any two parties whether they be a natural persons, departments, computer systems or organizations." Since the invention of King is directed to wireless client systems, this assertion by the appellant is in unambiguous contradiction to the appellant's arguments and plainly places King within the scope and intent of the specification and claims as written.

Continuing, the appellant asserts that King and Kroenke teach away from the claimed subject matter. Again, the Examiner respectfully disagrees and points to the appellant's specification, page 20, lines 28-29, wherein the appellant unmistakably states, "The (privacy)

Art Unit: 3621

agreement can be between any two parties whether they be a natural persons, departments, computer systems or organizations." Since the invention of King is directed to wireless client systems, this assertion by the appellant is in unambiguous contradiction to the appellant's arguments and plainly places King within the scope and intent of the specification and claims as written. Moreover, Kroenke is not relied upon to show a privacy agreement, but rather to teach implementation of a privacy agreement in an Object-Oriented framework, as described by the appellant in the specification.

Appellant goes on to assert that a suggestion or motivation to combine reference teachings is absent in this case. The examiner disagrees and points at least to King paragraph 0007, as well as Kroenke, pages 59+, Documentation of Business Rules. As one of ordinary skill in the art would attest as is shown by the combination of King/Kroenke, Business rules i.e. privacy agreements, may be easily incorporated and implemented within the Object-Oriented environment.

Appellant asserts that the cited references are not in the same field, and are not reasonably pertinent to the same problem. The examiner respectfully disagrees. All prior art of record directed to a similar field of endeavor because all use computer implemented methods to solve similar problems.

Issue 3

With regard to the Applicant's assertions that the prior art of record does not fairly teach or disclose each and every limitation contained within claim 2, it appears as if the Applicant is reading limitations into the claims from the specification. Consequently, the points argued are

Art Unit: 3621

not recited in the claim themselves. The Examiner has taken the broadest and most reasonable interpretation of the claim limitations as written, in light of the specification. Although the specification may contain recitations of intended use, alternative points of view and subjective interpretative differences between the prior art of record and the present invention as premeditated, it is the claims themselves that are given patentable weight only inasmuch as they are constructed. As such, Kroenke discloses entity relationship diagrams that show cardinality between classes and entities (see at least Figures 3-3). Kroenke also discloses that there are many different ways of modeling a business situation using the relational data base environment (page 67).

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

This examiner's answer contains a new ground of rejection set forth in section (9) above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) Reopen prosecution. Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of

Art Unit: 3621

rejection. A request that complies with 37 CFR 41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

Respectfully submitted,



ANDREW J. FISCHER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600

Joshua Murdough



Vincent Miller
Appeals Practice Specialist

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:



WYNN W. COGGINS
TECHNOLOGY CENTER DIRECTOR